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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,504	06/26/2003	James P. Peterson	200920-9007	5220
1131	7590	02/14/2006	EXAMINER	
MICHAEL BEST & FRIEDRICH LLP Two Prudential Plaza 180 North Stetson Avenue, Suite 2000 CHICAGO, IL 60601			SHEWAREGED, BETELHEM	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/606,504

Applicant(s)

PETERSON, JAMES P.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18,19,21-27 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,19,21-27,30-34,36 and 37 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/2/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's response filed on 11/02/2005 has been fully considered. The Claim Objections have been withdrawn in view of Applicant's amendment.
2. Claims 1-17, 20, 28 and 29 are cancelled, claim 18, 21-23, 26, 27, 30, 31 and 33-35 are amended, claims 36 and 37 are added, and claims 18, 19, 21-27 and 30-37 are pending.

### ***Claim Rejections - 35 USC § 102***

3. Claims 18, 19, 21-24, 26, 27, 30-34, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 4,946,532).

A multilayer web construction comprising a release liner, a release coating (R) on the release liner, an adhesive coating (s) on the release coating (R), and a facestock on the adhesive coating (s), wherein the facestock is die-cut to form pressure sensitive labels (Fig. 3A-3D and col. 6, line 21). The facestock is equivalent to the claimed plastic plate, the release coating (R) is equivalent to the claimed backing material, and the release liner is equivalent to the claimed rigid base. The facestock may comprise polyvinylchloride (col. 10, line 14 and col. 11, line 26-28), and may be corona treated to increase printability of the layer (col. 10, line 23). Roughness at a face may be provided by embossing effect (col. 8, line 52).

***Response to Arguments***

4. Applicant's argument is based on that the prior art discloses a continuous web of material that is fed through a high speed label processing machine that handles continuous webs of material and creates labels. Also Applicant argues that the prior art does not teach the limitation of a fixed size and shape. This argument is not persuasive because the argument is based on a process limitation. Process limitations do not affect the issue of the patentability of the article claims. The limitation of a fixed size and shape is not a positive limitation because the value of the size and the type of the shape have never been recited in any on the claims, and also once the labels of the prior art are created the labels automatically possess a certain size and shape. Thus claims 18, 19, 21-24, 26, 27 and 30-34 stand rejected, and claims 36 and 37 are included in the rejection.

5. Claims 18, 19, 21, 22, 24, 27, 30, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Scholz et al. (US 6,461,707 B1).

Scholz discloses a PSA (pressure sensitive adhesive) label comprising a liner, a releasable material on the liner, and a PSA layer on the releasable material, and a facestock on the PSA layer, wherein the label is printed cut and stripped to form the desired shape and size (col. 3, lines 26-48). The liner is equivalent to the claimed rigid base, the releasable material is equivalent to the claimed backing material and the facestock is equivalent to the claimed plastic plate.

***Response to Arguments***

6. Applicant has failed to response to the above USC 102(e) rejection anticipated by Scholz.

***Claim Rejections - 35 USC § 103***

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532), as applied to claims 18, 19, 21-24, 26, 27, 30-34, 36 and 37, above.

Freeman discloses the claimed invention except for slots or holes in the pressure sensitive labels. It would have been obvious matter of design choice to make slots or holes in the labels, since applicant has not disclosed that the slots and holes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the slots and holes.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scholz et al. (US 6,461,707 B1), as applied to claims 18, 19, 21, 22, 24, 27, 30, 32, 34, 36 and 37, above.

Scholz discloses the claimed invention except for slots or holes in the pressure sensitive labels. It would have been obvious matter of design choice to make slots or holes in the labels, since applicant has not disclosed that the slots and holes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the slots and holes.

***Response to Arguments***

9. Applicant's argument to the USC 103(a) rejections over Freeman and Scholz is based on that the prior arts do disclose the limitation of claim 25. This argument is not persuasive because even though the limitation of claim 25 is not expressly disclosed in the prior art, the examiner has shown the deficiency of the prior arts, and the examiner further explained why it would be a matter of a design choice to incorporate the limitation of claim 25. Since applicant has not disclosed the criticality of the slots and holes to the claimed invention, or is for any particular purpose and it appears that the invention would perform equally well with the slots and holes. Thus claim 25 stand rejected.

***Allowable Subject Matter***

10. Claim 35 is allowed over Freeman and Scholz.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.  
February 8, 2006.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER